

## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges the reply filed 09/05/2008 in which claims 2-17, 22, and 27 were amended and new claims 33-34 were added. Currently claims 2-31 and 33-34 are pending for examination in this application. Examiner also acknowledges the amended specification, abstract and new drawing sheet of Figure 2a filed 09/05/2008.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) that was submitted on 05/09/2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 18-24, and 26 are rejected under 35 U.S.C 103(a) as being unpatentable over Dieras et al. (USPN4,804,364) in view of Christ et al. (USPN5,984,889). Dieras et al. discloses an apparatus for the curettage or exeresis of biological tissue by means of ultrasonic vibration.

Regarding claims 18-24, and 26, Dieras et al. discloses a medical treatment apparatus (Figure 1) capable of being used for wound treatment with a hand piece (18) equipped with an ultrasound vibration generator (6) with electric connection means (11) and a sonotrode (14) attached to the hand piece (18), characterized in that wherein a channel (lumen of 14) is disposed within the sonotrode for feeding a medical flushing liquid to a tip of the sonotrode (near 2) via a flushing line (4) connector; wherein an adaptation sleeve (7) can be slid over the sonotrode (14) of the medical treatment apparatus and wherein the adaptation sleeve (7) can be attached at the hand piece (near 19), wherein the adaptation sleeve (7) is equipped with a connector (lumen near 15) for receiving a suction hose (Figures 1-7, cols 1-2).

Dieras et al. meets the claim limitations as described above except for a valve within the flushing line and a screw type sleeve connection.

However, Christ et al. teaches an apparatus and method for ultrasonic tissue intervention.

Regarding claims 18-24, and 26, Christ et al. teaches a medical treatment apparatus (Figure 2) capable of being used for wound treatment with a hand piece (28) equipped with an ultrasound vibration generator (32) operating at 20-100kHz (col 4, In 25-40) and a sonotrode (20) attached to the hand piece (28), characterized in that

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wherein a channel (lumen of 20) is disposed within the sonotrode for feeding a medical flushing liquid to a tip of the sonotrode (near 20) via a flushing line (near 126) connector with a valve interface; wherein an adaptation sleeve (7) can be slid over the sonotrode (14) of the medical treatment apparatus and wherein the adaptation sleeve (12) can be attached at the hand piece (near 28) via a threaded connection (Figures 1-4).

At the time of the invention, it would have been obvious to add the fluid control valve and the threaded sleeve connection in order to add fluid control and easy cleaning and disassembly of the unit. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Christ et al. (cols 1-2).

### ***Claim Rejections - 35 USC § 103***

Claim 25 are rejected under 35 U.S.C 103(a) as being unpatentable over Dieras et al. (USPN4,804,364) in view of Christ et al. (USPN5,984,889). The modified Dieras et al. meets the claim limitations as described above except for the opacity of the fluid lines and ultrasound drive materials.

Regarding claim 25, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the fluid tubes of an opaque or non-opaque substance in order to see the contents or get optimal pressure resistance depending on the material selected and it would have been obvious to substitute the piezoelectric drive with a magneto drive since both are well known ultrasound generation means, since it has been held to be within the general skill of a worker in the

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art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

### ***Allowable Subject Matter***

Claims 2-17, 27-31 and 33-34 are allowed.

### ***Response to Arguments***

Applicant's arguments filed 09/05/2008 have been fully considered but they are not persuasive. Applicant's Representative asserts that the combination of the Dieras et al. (USPN4,804,364) in view of Christ et al. (USPN5,984,889) does not disclose the invention as claimed.

Examiner has fully considered applicant's arguments but they are not persuasive. It is examiners position that given a careful reading, the claims do not distinguish over the prior art of record.

Examiner asserts that prior art of record discloses the claimed subject scope. Applicant's Representative asserts that the reference does not present any suggestion for smoke treatment by suctioning and each reference only contains a small aspiration conduit. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., smoke evacuation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the removal of smoke, the Examiner contends that the Dieras et al. and Christ et al. references are capable of removing smoke creating during the procedure. It is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, i.e., a functional limitation, does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim, see *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974).

The prior art of record teaches all elements as claimed and these elements satisfy all structural, functional, operational, and spatial limitations currently in the claims. Therefore the standing rejections are proper and maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER D. KOHARSKI whose telephone number is (571)272-7230. The examiner can normally be reached on 5:30am to 2:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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